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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,038	08/09/2001	Bart D. Hibbs	35140.002	5237

21907 7590 04/08/2003

ROZSA & CHEN
15910 VENTURA BOULEVARD
SUITE 1601
ENCINO, CA 91436

EXAMINER

GONZALEZ, JULIO C

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,038

Applicant(s)

HIBBS ET AL.

Examiner

Julio C. Gonzalez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: in figure 1, reference 140; in figure 3A, reference 142; in figure 4B, reference 162; in figure 5A, references 132, 134, 130; in figure 6, reference 122; in figure 7, references 116, 114; in figures 8A & 8B, references 140, 190, 150, 200, 124, 190. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to because figures 5A, 5B seemed to show that reference 130 is a mooring, but it may seem like what reference 130 is pointing out is the bottom of the ocean floor, is it? A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means attached to one floating device for generating electricity as disclosed in claim 1 and

the counter-weight device connected to another end of the tether as disclosed in claim 5 and generating means attached to one tether at a location adjacent to the float as disclosed in claim 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "142" has been used to designate both turbine and collar. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure does not specify how the horizontal movement of the float will generate electricity or how will the device move back and forth horizontally. From figure 1, for example, it would seem as if the float would only move vertically.

Even more, it may seem like if the float 110 in figure 1 does not move horizontally at all. What seems to be moving are the waves. Also, in page 16, paragraph 2, the specifications disclose that the float 110 will "oscillate horizontally in the direction of wave travel". It would seem like if the float will move in one direction

(direction of the wave), thus the float 110 would not be able to oscillate. How would the float move to the opposite direction of the wave?

Moreover, in page 17, paragraph 4, the specification disclose "tuning" may be achieved by a winch 112. How would the winch know the distance that is needed to be adjusted? Or the length of the tether that is needed? The specifications do not provide enough information as to how the "tuning" is performed. How the natural frequency is determined by the system? How can the natural frequency be adjusted (page 17, paragraph 3)?

Also, the specifications do not provide any information as to the electricity will be generated, especially for the descriptions of figures 8A and 8B. More specifically,

in figure 8B, how will the system move in such horizontally manner as illustrated in the figure? How will it go back and forth? What causes the back and forth movement to produce electricity?

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the claim discloses a floating device having a float. From the specifications, the float is 110, now what is considered to be the floating device? It may seem like if the float and floating device are the same.

In claim 6, what is considered to be the mechanism that lets the float move back and forth?

In claim 12, what is riding on the track, the roller or the interconnecting mechanism?

In claim 21, the "adjusting mens comprises" needs more clarification.

In claim 22, what are the means for generating electricity?

In order to advance prosecution in the merits, the Prior Art will be applied as best understood by the examiner.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 22, 27, 28, 29-31, 40 and 41 are rejected, AS UNDERSTOOD, under 35 U.S.C. 102(b) as being anticipated by Rubi.

Rubi discloses an apparatus for extracting energy from waves having a float 100, tether 203, mooring 200, means 506 for transporting electricity to a power facility 507 and that the float is able to move substantially in a horizontal direction (see figure 2) and generating means (see figure 3).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-21, 26 and 36-39 are rejected, AS UNDERSTOOD, under 35 U.S.C. 103(a) as being unpatentable over Rubi in view of Weyers.

Rubi discloses an apparatus for extracting energy from waves having a float 100, tether 203, mooring 200, means 506 for transporting electricity to a power facility 507 and that the float is able to move substantially in a horizontal direction (see figure 2) and generating means (see figure 3).

However, Rubi does not disclose a mechanism connected to the tether and a float.

On the other hand, Weyers discloses for the purpose of obtaining maximum efficiency in converting sea wave energy into useful rotational energy, a device floating on the ocean (see figure 3) having a plurality of tethers 50 with each tether having its own mooring device 52 and rollers 52.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design an apparatus for extracting energy from waves as disclosed by Rubi and to modify the invention by using multiple tethers for the purpose of obtaining maximum efficiency in converting sea wave energy into useful rotational energy as disclosed by Weyers.

13. Claims 5, 6-12 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubi in view of Windle.

Rubi discloses an apparatus for extracting energy from waves having a float 100, tether 203, mooring 200, means 506 for transporting electricity to a power facility 507 and that the float is able to move substantially in a horizontal direction (see figure 2) and generating means (see figure 3).

However, Rubi does not disclose a mechanism that may have a counter-weight device and able to move back and forth horizontally.

On the other hand, Windle discloses for the purpose of obtaining an inexpensive energy extraction apparatus and easy to manufacture, a device having a float 12, tether 18, mooring device 36, generating means (see figure 1), rollers 64A, and that the device can move horizontally back and forth (see figure 5)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design an apparatus for extracting energy from waves as disclosed by Rubi and to modify the invention by having a horizontal back and forth movement for the purpose of obtaining an inexpensive energy extraction apparatus and easy to manufacture as disclosed by Windle.


14. Claims 13-15, 23-25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubi in view of Robson.

Rubi discloses an apparatus for extracting energy from waves having a float 100, tether 203, mooring 200, means 506 for transporting electricity to a power facility 507 and that the float is able to move substantially in a horizontal direction (see figure 2) and generating means (see figure 3).

However, Rubi does not disclose a winch for adjusting a tether.

On the other hand, Robson discloses for the purpose of providing a generating plant that has improved directional stability, a float 11, generating means 17, generator 58, tether 3 and 4 (see figure 2 & 12) and an electric winch (column 17, lines 63-66).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design an apparatus for extracting energy from waves as disclosed by Rubi and to modify the invention by using a winch for the purpose of providing a generating plant that has improved directional stability as disclosed by Robson.


NESTOR RAMIREZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is (703) 305-1563. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jcg

April 1, 2003